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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark A. Autry	§	Group Art Unit:	2116
		§		
Serial No.:	09/928,162	§		
		§	Examiner:	James K. Trujillo
Filed:	August 10, 2001	§		
		§		
For:	Upgrading a Bios	§	Atty. Dkt. No.:	ITL.0627US
		§		(P12027)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY TO OFFICE ACTION DATED MAY 28, 2004

Dear Sir:

Please consider the comments in the following REMARKS section.

REMARKS

In an Office Action mailed on May 28, 2004, claims 1-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Choi in view of Firooz. These rejections are discussed below.

Rejections of Claims 1-9:

The method of independent claim 1 includes modifying a first basic input/output system image by replacing a first portion of the first basis input/output system image with a portion of the second basic input/output system image.

Contrary to the limitations of independent claim 1, as acknowledged by the Examiner, Choi fails to teach or suggest modifying a first basic input/output system image by replacing a portion of the first basic input/output system image with a portion of a second basic input/output system image. Therefore, the Examiner relies on Firooz to reject independent claim 1 under 35 U.S.C. § 103. However, the Examiner fails to show where the prior art teaches or suggests modifying a first basic input/output system image by replacing a portion of a second basic input/output system image.

More specifically, the Examiner relies on Firooz for the basic proposition of modifying a particular firmware image. For example, the Examiner refers to lines 21-27 in column 1 of Firooz, language that merely states that a device may modify or replace its own firmware. This language does not, however, even mention a basic input/output system image. In fact, the only specific type of firmware mentioned is firmware on a modem. Likewise, the language in Firooz discussed in Fig. 3 also fails to mention a basic system input/output image and thus, fails to teach or suggest the missing claim limitations. Thus, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 1 for at least the reason that the combination of Firooz and Choi fails to teach or suggest all claim limitations, such as modifying a first basic input/output system image by replacing a portion of the first basic input/output system image with a portion of a second basic input/output system image.

"Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Rather, the Examiner must show that one skilled in the art, *not having knowledge of the claimed invention*, would have combined Firooz and Choi to

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derive the claimed invention. Due to the failure to make this showing, a *prima facie* case of obviousness has not been established for independent claim 1.

Claims 2-9 are patentable for at least the reason that these claims depend from an allowable claim.

Rejection of Claims 10-18:

The computer system of independent claim 10 includes a processor that modifies a replacement basic input/output image by replacing a replacement basic input/output system image with a portion of an existing basic input/output system image.

The Examiner fails to show where the combination of Choi and Firooz teaches or suggests the above-referenced limitations. Rather, the Examiner relies on the general discussion of a firmware modification in Firooz to allegedly teach these missing claim limitations. However, Firooz fails to teach or suggest several elements that are neither taught nor suggested in Choi For example, Firooz fails to teach the modification of a basic input/output system image. Likewise, Firooz fails to teach the modification of a *replacement* basic input/output system image. Therefore, for at least any of these reasons, the combination of Choi and Firooz fails to teach or suggest all claim limitations. Therefore, a *prima facie* case of obviousness has not been established for independent claim 10.

Claims 11-18 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 19-27:

The article of independent claim 19 includes a computer readable storage medium that stores instructions to cause a processor to modify a replacement basic input/output system image by replacing a portion of the replacement basic input/output system image with a portion of an existing basic input/output system image that is stored in a firmware memory.

See discussion of independent claim 10 above. In particular, the combination of Choi and Firooz fails to teach or suggest instructions to cause a processor to modify a replacement basic input/output system image by replacing a portion of the replacement basic input/output system image with a portion of an existing basic input/output system image that is stored in a firmware
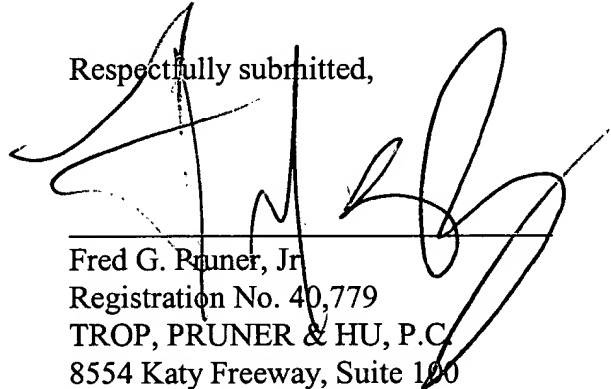
memory. Thus, a *prima facie* case of obviousness has not been established for independent claim 19.

Claims 20-27 are patentable for at least the reason that these claims depend from an allowable claim.

CONCLUSION

In view of the foregoing, withdrawal of the § 103(a) rejections of claims 1-27 and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0627US).

Respectfully submitted,

Date: June 11, 2004

Fred G. Pruner, Jr
Registration No. 40,779
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, Texas 77024
(713) 468-8880 [Phone]
(713) 468-8883 [Fax]